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| 09/756,984      | 01/08/2001  | Srinivas Akkaraju    | 010519-0004-999     | 6823             |

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EXAMINER

BOYCE, ANDRE D

ART UNIT PAPER NUMBER

3623

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/756,984

Applicant(s)

AKKARAJU, SRINIVAS

Examiner

Andre Boyce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 1-12 have been examined.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "said predetermined questions". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

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For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter.

For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case the independent claim 1 only recites an abstract idea. The recited steps of receiving answers, acquiring responses, calculating a first sum, etc., does not involve, use, or advance the technological arts (i.e., computer, processor, electronically, etc.), since the steps could be performed using pencil and paper.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case the claimed invention calculates and computes sums, thereby producing a useful, concrete, and tangible result, but not within the technological arts as explained above.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3 and 5-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al (USPN 6,643,660), in view of Durand et al (USPN 6,272,467).

As per claim 1, Miller et al disclose a method for facilitating a transaction of a life sciences opportunity between first and second parties (technical study contracting process (TSCP), wherein a sponsor is a buyer of services and a vendor offer services, including pharmaceutical drug research, column 1, lines 21-25 and column 7, lines 61-67), comprising: receiving answers to predetermined life sciences opportunity questions from a first party (i.e., questions concerning the vendor's capabilities); and acquiring responses to said predetermined life sciences opportunity questions from a second party (i.e., questions concerning the buyer's desires, wherein the vendor capability questions and buyer desire questions must overlap in order to determine vendors capable of supplying a quote, column 8, lines 17-23).

Miller does not disclose calculating a first sum of all of said responses that match said answers, for each of said predetermined life sciences opportunity questions; computing, from said answers and said responses, a second sum of all of said questions that both said first party and said second party deem to be applicable to said transaction, for each of said predetermined life sciences opportunity questions; and displaying said first sum and said second sum to said second party, such that said second party can assess said life sciences opportunity. Durand et al discloses a compatibility/opportunity matching service (column 6, lines 5-8), wherein a list of acceptable matches, including the profile 17 information (i.e., a total of all the

matching characteristics between the parties) is made available via the output program 5, for both parties to view (column 6, lines 35-45). Further, Durand et al disclose a composite score, which is a weighted sum of how close a match may be (column 14, lines 11-13). Both Miller et al and Durand et al are concerned with effective opportunity matching, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include totaling and displaying the matching characteristics of the vendor and buyer in Miller et al, thereby providing additional information to the buyer in order to determine which vendor can provide the best service, thereby making the Miller et al system more robust.

As per claims 2 and 3, Miller et al does not disclose a step prior to said displaying step of generating a ratio of said first sum to said second sum, where said ratio is an indication of compatibility of said life sciences opportunity to transaction requirements of said second party, and producing said ratio where a numerator of the ratio is the first sum and a denominator of the ratio is the second sum. Durand et al disclose a numeric index of compatibility between a user's preference profile and a potential match's trait profile (column 12, lines 32-37), wherein, the basic compatibility score includes a ratio (column 13, lines 45-52). Both Miller et al and Durand et al are concerned with effective opportunity matching, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include response ratios in Miller et al, thereby providing additional

information to the buyer in order to determine which vendor can provide the best service, thereby making the Miller et al system more robust.

As per claim 5, Miller et al disclose said predetermined questions are technical questions relating to life sciences opportunities (i.e., complex technical studies, pharmaceutical drug research, etc., column 7, lines 61-67).

As per claims 6 and 7, Miller et al does not disclose determining said first sum of all of said responses that match said answers for each of said predetermined life sciences opportunity questions, and where each response and each answer are "Yes," and determining from said answers and said responses, a second sum of all of said questions that said first party did not provide a "Not Applicable" answer to, and of all of said questions that said first party provided a "Yes" response to, for each of said predetermined life sciences opportunity questions. However, Applicant is merely adding up the total number of answers in various ways, in order to determine response overlap, which is a logical extension of Miller et al in view of Durand et al, as seen in the rejection of claim 1, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include totaling the responses in order to determine overlap of the vendor and buyer in Miller et al, thus providing additional information to the buyer in order to determine which vendor can provide the best service, thereby making the Miller et al system more robust.

As per claim 8, Miller et al disclose notifying the second party when a life sciences opportunity matching transaction requirements of said second party

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becomes available (ToxBid routes bids and communication between the sponsor and capable vendors, using technical capability filters, column 8, lines 23-27).

As per claim 9, Miller et al disclose notifying step includes the step of sending an electronic message to the second party (message sent via ToxWeb, column 5, lines 51-54).

As per claim 10, Miller et al disclose said first party is a seller of a life sciences opportunity and said second party is a buyer of a life sciences opportunity (i.e., pharmaceutical firms requesting services from clinical research organizations, column 2, lines 39-42) .

Claims 11 and 12 are rejected based upon the rejection of claims 1 and 2, respectively, since they are the computer program product claims corresponding to the method claims.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al (USPN 6,643,660), in view of Durand et al (USPN 6,272,467), in further view of Callender (US 2002/0119433).

As per claim 4, Miller et al does not disclose said answers and said responses are selected from a group consisting of: "Yes", "No", and "Not Applicable." Callender discloses a question prototype that represents the possible methods for answering a question statement, including yes/no answers (¶ 0096). Both Miller et al and Callender are concerned with collecting information effectively, therefore it would have been obvious to one having ordinary skill in the art at the time the invention



was made to include yes/no answers in Miller et al, thereby providing simple responses usable in order to determine which vendor can provide the best service, thereby making the Miller et al system more robust.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Harrell et al (US 2002/0016727) disclose dynamically matching knowledge capital with developers.

-Walker et al (USPN 6616458) discloses creating respondent questions based on survey results.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre Boyce whose telephone number is (703) 305-1867. The examiner can normally be reached on 9:30-6pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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